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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/868,216	06/03/1997	JOSEPH GIORDANO III	INFG0002	3161

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

11

Office Action Summary

Application No.
08/868,216

Applicant(s)
Giordano III

Examiner
Steven Nguyen

Art Unit
2664



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 19, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-6, 8-20, 22, 24-29, 31-50, and 52-65 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-6, 8-20, 22, 24-29, 31-50, and 52-65 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Art Unit: 2664

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-20, 22, 24-29, 31-50 and 52-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (USP 5946647) in view of Shachar (USP 5764736) and Pandit (USP 5859636).

Regarding claims 1-6, 8-20, 22, 24-29, 31-50 and 52-65, Miller (Fig 1-10 and Col. 1, lines 5 to col.7, lines 6) discloses a method of performing on a document, a word processor or any text, containing text information during communication session which comprises the step of parsing (Fig 3, Ref 310 is a parser for parsing the received document for identifying telephone number, automatically dial the number without the user to enter telephone number), recognized the telephone number (Fig 4 for recognizing the telephone numbers within a received document) and adding code to form a telephone icon such screen label, a graphic button, highlighted (adding code to create a highlighting to create a pull down or pop-up menu for allowing the user to select for dialing or storing the telephone number, See Fig 6-10) for displaying on the GUI (See col 5, lines 5-50 and col 6, lines 8-25). However, Miller does not disclosed Parsing HTML code and transparently disconnecting from Internet session upon selection of the telephone number and

Art Unit: 2664

storing a telephone number in the address book. In the same field of endeavor, Shachar (Fig 1-4 and col. 1, lines 20 to col. 14, lines 67) discloses transparently disconnecting from the session upon the user clicks on the telephone icon to dial the number (Col 6, lines 1-14); reconnecting a data session when a telephone session is terminated (Col 6, 11-14); pattern-recognizer (See Fig 4a, 410 for recognizing the telephone number); Internet capable telephone for recognizing a telephone number in the telephone tag "telephone icon" (Col 6, lines 24-26 and col 5, lines 52-60); after interpreting the text information and adding code, a web browser will display a web page with all the information such as telephone number with graphic associated with it (Col 5, lines 42-47 and Fig 4a, Ref 410-418) and Pandit discloses a step of recognizing a telephone number from any document such as Netscape and storing a telephone number in the address book (See Fig 1e and 1f Ref 20 for recognizing a telephone number and Fig 2, Ref 22);

Since, Pandit suggests a method of recognizing a telephone number from any document such as Netscape (See col 1, lines 42-49) and Miller suggests a document which is generated by an applicant program such as wordprocessor (See col 3, lines 36-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to applying the method of transparently connecting or disconnecting the communication session and storing a recognized telephone number into an address book as disclosed by Shachar and Pandit into Miller's communication system. The motivation would have been to prevent human error. Furthermore, the method of recognizing a pattern is well known in the art for recognizing the text telephone number.

Art Unit: 2664

Response to Arguments

3. Applicant's arguments filed 7/23/2001 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Miller discloses a method and apparatus for parsing and recognizing a telephone number from a document which is obviously included HTML document, Word Perfect document, HTML Email and text etc. because the recitation "document" is a generic term of the HTML and Word Perfect (See Paragraph 2 of the office action). The software will add the code into the document to create a hight light with a drop down menu in the document to allow a user to dial the telephone number or store in the address book. Pandit discloses a method and apparatus for parsing and recognizing (See Fig 1e and 1f for recognizing a telephone number and Fig 2, Ref 22) the telephone number for displaying into a Netscape browser which is usually displayed an HTML document which is received from a web site (See col. 5, lines 12-24). Shachar discloses a method and apparatus for recognizing a telephone number from a received HTML document and storing the telephone number and its associated code graphic button in the

Art Unit: 2664

storage (See paragraph 2 of office action). After parsing completely the HTML document, the software will retrieve data and create the graphical image to generate an HTML document for display on the monitor (Fig 4a, Ref 410-418). Therefore, it would have been obvious to one of ordinary skill in the art to apply a method of recognizing a telephone number which is received from a world wide web site as disclosed by Pandit and a method of creating a graphical image such as button and recognized telephone number as disclosed by Shachar into a method and apparatus of Miller.

Furthermore, the applicant states that (1) Netscape is not parse and display an HTML document and (2) recognizing a telephone number and converting the recognized telephone number into a selectable icon telephone number by adding a code into an HTML code wherein these telephone number is not previous iconic telephone number. In reply, With respect (1), Pandit discloses a Netscape software which is used to display a received HTML document from a world wide web site (See col. 5, lines 12-24). This feature is well known in the art. With respect (2), Miller discloses a method and apparatus for recognizing a telephone number which is not previous iconic from a document and add a code into a document to create pull down menu to allow a user to dial telephone number or save the telephone number into an address book which is convenience to a user (Fig 4, 7-10 which disclose method and apparatus for parsing and recognizing a telephone number from a document which is obviously included HTML document, Word Perfect document, HTML Email and text etc. because the recitation "document" is a generic term of the HTML and Word Perfect. The software will add the code into the document

Art Unit: 2664

to create a hight light with a drop down menu in the document to allow a user to dial the telephone number or store in the address book). Therefore it would have been obvious to one of ordinary skill in the art to create a graphic button of telephone number and adding the code into a document such as HTML by applying Shachar's a method and apparatus such as storing a recognized telephone number and its associated button when parsing the HTML document. After parsing the completed document, the browser will retrieve the recognized telephone number and generate a graphic button to create an HTML document for display on the monitor (See paragraph 2 of office action and Fig 4).

The teaching of Miller and Pandit and Shachar perform the claimed invention. Therefore, the rejection maintains.

Conclusion

4. The office action which is mailed on 10/9/2001, have been vacated.
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2664

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2664
January 26, 2002



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